

### **REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 7, 10-11, 15 and 28-29 are requested to be cancelled without prejudice or disclaimer.

Claims 1, 8-9, 12, 14, 16-17, 23, 30 and 32 are currently being amended. No new matter is added.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-6, 8-9, 12-14, 16-18, 20-27 and 30-33 are now pending in this application.

### **Drawings**

The drawings were objected to under 37 CFR 1.83(a). Specifically, the Office Action stated that all of the limitations of claims 2-16, 18, and 20-33 must be shown or the feature(s) cancelled from the claims(s). Applicants submit that no further drawings or drawing amendments are required in the present application.

For example, with respect to the method claims 2-13, 18-28, and 30-31, the steps recited therein are further definitions of the steps already shown in the flow chart of Figure 1. Thus, these steps are shown in the drawings. The specific description of these steps is also fully supported by the specification.

With respect to claims 16, 29, 32 and 33, these claims are directed to an embodiment of the invention directed to a system with components that implement the steps of Figure 1, as these steps are further defined. The specific description of these implemented steps is also fully supported by the specification.

Moreover, applicants note that 35 U.S.C. 113 requires a drawing only “where necessary for the understanding of the subject matter to be patented.” In the present case, an understanding of the subject matter to be patented, as embodied in the claims, is clear from Figure 1 in its current form along with the specification. Thus, no further drawings, or drawing amendments are required.

Still further, applicants submit that there is no requirement that the exact wording of the claims be reproduced in the figures, as long as the invention as claimed can be understood from the disclosure. It is well known in U.S. patent practice, such as in the chemical arts for example, that many claimed inventions require no drawings whatsoever. In the present case, no further drawing or drawing amendments are required to understand the invention. To require that “all of the limitations” of claims 2-16, 18, and 20-33 be expressly shown in detail in the drawing would amount to an unnecessary and burdensome requirement that much of the text of the specification be transposed to the drawings. Such an amendment is not necessary for the present application, where the claims can be well understood without.

For at least the above reasons, applicants request that the objection to the drawings be withdrawn.

#### **Rejection under 35 U.S.C. §§ 101**

Claims 1-13 and 16-33 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically the Office Action states “[w]ith respect to independent claims 1, 16, 17, 23, 28-30 and 32, the claims do not require use of a computer system, and therefore, the methods and apparatuses implementing those methods are not patentable.” In response, the pending independent claims (other than claim 14 which was not rejected under 35 U.S.C. 101) have been amended to recite steps or components performed by or implemented by computer components, such as a processor or memory. Accordingly, applicants respectfully request that the rejection under 35 U.S.C. 101 be withdrawn. The rejection of claim 7 under 35 U.S.C. 101 is moot in light of the cancellation of that claim.

#### **Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1-13 and 16-33 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by a floppy disk being acted upon by human action and mental process. Claims 1-6, 8-10, 12-17, 23, 26, 28, 30 and 32 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,000,006 to Bruce et al. (hereafter "Bruce"). Claims 1-17 and 20-22 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication #2002/0107832 A1 to Shimizu et al. (hereafter "Shimizu"). Claims 23-26 and 28-33 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,478,679 to Himoto et al. (hereafter "Himoto"). Claims 11, 20-22, 24-25 and 28-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce. Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu and Bruce, in view of U.S. Patent No. 5,532,689 to Bueno (hereafter "Bueno"). Claim 27 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Himoto and Bruce, in view of U.S. Patent No. 6,587,140 to No (hereafter "No"). Applicants respectfully traverse these rejections, insofar as they can be applied to the claims as amended, for at least the following reasons.

With respect to the rejection over a floppy disk being acted upon by human action and mental process, as discussed above with respect to the rejection under 35 U.S.C. 101, the pending independent claims (other than claim 14 which was not rejected under 35 U.S.C. 101 or 102) have been amended to recite steps or components performed by or implemented by computer components, such as a processor or memory. Accordingly, applicants submit that a floppy disk being acted upon by human action and mental process alone does not anticipate any of the independent claims.

The remaining references of Bruce, Shimizu, Himoto, Bueno and No, either alone or in combination, fail to anticipate or render unpatentable, any of the pending claims, for at least the following reasons.

Bruce discloses a flash memory system in Fig. 4 including a cache 22, unified re-map table 20, and bus 32 to flash memories 24 and 26, where the flash memories may be flash-memory chips or cards of flash memory chips such as flash PC cards (Fig. 4, col. 6, lines 35-41). The unified re-map table 20 is contained in volatile SRAM memory, and a back-up copy 28 of the re-map table is stored in flash memory 26 (col. 6, lines 43-45).

In contrast to independent claim 1, however, Bruce does not disclose “displaying the information about the usage of the memory card on a display on the memory card.”

Presuming for the sake of argument that the cards of flash memory chips such as flash PC cards disclosed in Bruce could be considered to be a memory card (which it is not), Bruce does not suggest that such cards either have a display, or that any display on the cards display the information about usage of the cards. Thus Bruce fails to anticipate or render obvious independent claim 1.

Independent claims 16, 17 and 23 recite corresponding limitations to those discussed with respect to claim 1, and are thus patentable over Bruce for analogous reasons.

With respect to independent claim 14, Bruce does not disclose “wherein for each of a plurality of event descriptors an amount of memory used by an aggregation of events corresponding to respective each of the event descriptors” as recited in claim 14. With respect to this limitation, which was imported from claim 15, the Office Action on page 10 cites to element 44 of Figure 6 of Bruce. Element 44 of Bruce, however, is a physical block address (see col. 6, lines 60-65), not an amount of memory. Thus, Bruce fails to anticipate or render obvious independent claim 14.

With respect to independent claims 30 and 32, Bruce does not disclose “wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card” as recited in these claims. With respect to this limitation, which was imported from claim 15, the Office Action on page 11 cites to Bruce in column 5, lines 5-12, and states “[t]his effectively keeps track of the number of times data was corrected by preventing it from having to be corrected.” The cited section of Bruce, however, fails to disclose the number of times data was corrected by any memory card. The fact that Bruce may suggest preventing data from having to be corrected is not a disclosure of accessing that information from any memory card. Thus, Bruce fails to anticipate or render obvious independent claims 30 or 32.

The references of Shimizu and Himoto also fail to suggest the limitations of the independent claims. With respect to Shimizu and independent claims 1, 16, 17 and 23,

Shimizu fails to disclose displaying information about the usage of a memory card on a display on the memory card. While Shimizu discloses an output apparatus 710 consisting of a number of components including a memory card (see paragraph [0047]), Shimizu does not disclose that the memory card has a display which displays information about the usage of the memory card. Moreover, Shimizu discloses that the output apparatus 710 consists of a monitor (see paragraph [0047]), so presumably any information that is displayed would be displayed on the monitor, not the memory card.

Moreover, as argued in detail in the Appeal Brief filed on November 14, 2004, Shimizu and Himoto also fail to disclose other features of the independent claims. These arguments continue to apply as discussed further below.

***Shimizu does not disclose information about usage of a memory card in the manner recited in the claims.***

All of the independent claims require steps or components for performing steps regarding information or event descriptors about usage of a memory card. For example, independent claim 1 recites “recording the information about usage of the memory card in an area of memory of the memory card.” With respect to this feature, the Office Action on page 12, states: “Recording the information about usage of the memory card in an area of the memory card is disclosed in paragraph 61 [of Shimizu] as the generated use condition information and the billing information being recorded in the control information storage unit 726.” Applicants submit, however, that Shimizu fails to suggest the recording step as recited in claim 1, either in paragraph 61 or in any other portion of Shimizu.

Shimizu discloses in paragraph 61 recording generated use condition information and billing information in a control information storage unit 726 of a website, where the use condition information includes period of rent, number of times reproduction is possible, and whether or not copying is allowed.

Shimizu, however, fails to disclose recording information about the usage of a memory card in paragraph 61, or anywhere else in Shimizu. Applicants submit that the number of times a website has been accessed cannot reasonably be interpreted as the usage of

a memory card, whether or not the number of times is stored on the memory card. Since it represents usage of the web site and is unrelated to any usage of the memory card. Moreover, the generated use condition information and billing information disclosed in paragraph 61 is directed to rental of a DVD (See Shimizu, paragraph 61), and also cannot be reasonably interpreted as usage of a memory card. For example, the number of times the reproduction is possible concerns reproduction of a DVD, not the usage of a memory card.

Independent claim 14 is directed to a data structure in a memory card. The data structure comprises computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event. Shimizu fails to disclose a computer readable storage containing at least one event descriptor about the usage of the memory card. Thus, claim 14 is likewise patentable over Shimizu.

Independent claim 16 is directed to a system for storing memory card usage information on a memory card, comprising a processor for collecting information about usage of the memory card, and an area of memory of the memory card for recording the information about usage of the memory card. Shimizu fails to disclose or suggest collecting information about the usage of a memory card, and storing that information in an area of memory of the memory card. Thus, claim 16 is likewise patentable over Shimizu.

Independent claim 17 is directed to a method. The method comprises collecting information about usage of a portable memory card in an electronic device using a processor, and recording the information about usage of the memory card in an area of memory on the memory card itself. Shimizu fails to disclose collecting information about usage of a portable memory card in an electronic device, and recording the information about the usage in an area of memory on the memory card itself. Thus, claim 17 is likewise patentable over Shimizu.

***The Examiner's interpretation of information about usage of a memory card is not reasonable.***

Applicants maintain (and have maintained throughout the prosecution of the present application) that the Examiner's interpretation of information about usage of a memory card

(or event descriptors about usage of a memory card) in the claims is not a reasonable interpretation of the claims. Claims under examination are to be given a broad reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) (emphasis added). The claim interpretation must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 15 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). The interpretation by the Examiner is not consistent with the plain language of the claims, the specification, file history of the present application, or the interpretation of those skilled in the art. If the claims are reasonably interpreted, the rejections based on Shimizu must fail.

The interpretation of the limitation of “information about usage of the memory card” to include a record of information concerning the use of rented DVDs, or the number of times a website has been accessed as disclosed in Shimizu is not a reasonable interpretation of that limitation. This interpretation is not consistent with the plain language of claim 1, the specification, or the file history of the present application.

In Shimizu, information concerning the use of rented DVDs is just that, information about the use of DVDs. This information is not about the usage or any other aspect of a memory card, even if that information about the use of DVDs happens to be stored on a memory card. The mere fact that general information is stored on a memory card does not make it information about the use of the memory card. This interpretation by the Examiner would essentially require that any information that is stored on a memory card be information about the use of the memory card merely because a memory card may act to store the information.

In sum, the plain meaning of “information about the usage of a memory card”, the specification, and the file history all make clear that general information is not information about the usage of a memory card merely because that information happens to be stored on a memory card. Thus, the interpretation of the limitation of “information about usage of the memory card” to include a record of information concerning the use of rented DVDs, or the number of times a website has been accessed as disclosed in Shimizu is not a reasonable interpretation of that limitation.

Dependent claims 1-6, 8-9, 12-13, 18 and 20-22 depend from one of independent claims 1 and 17, and are allowable for at least the same reasons, as well as for further patentable features recited therein.

Independent claims 23, 30 and 32 were rejected over Himoto. Himoto fails to suggest features in each of these independent claims.

Independent claim 23 recites “monitoring usage of the memory card”, and “storing the usage of the memory card” in an area of memory on the memory card. With respect to the limitation “usage of the memory card”, the Examiner states on page 18 of the Office Action: “[the] examiner has interpreted ‘usage of the memory card’ as the type of games stored and the respective scores, for example, as shown in figure 7, 8A, and 8B [of Himoto], as they are activities stored on the card that are not used by the card.” Applicants respectfully disagree with this interpretation.

Himoto discloses a memory card 10 with an LCD 14 that displays information such as game number and game scores (see Figures 7-8B). Himoto, however, does not disclose monitoring usage of the memory card, and storing the usage of the memory card in an area of memory on the memory card. The information displayed on the LCD 14 of Himoto, whether stored in the memory card 10 or not, cannot reasonably be interpreted as usage of the memory card for reasons analogous to those discussed above with respect to Shimizu.

In Himoto, information such as game number and game score is merely information about a game. This information is not about the usage of a memory card, even if that information concerning the game number and game score happens to be stored on a memory card. As discussed above with respect to Shimizu, the mere fact that general information is stored on a memory card does not make it information about the use of the memory card.

Moreover, the arguments with respect to the reasonableness of the Examiner’s interpretation of the “usage of the memory card” apply equally well to the rejection based on Himoto.



In sum, Himoto fails to disclose or suggest features recited in claim 23, and claim 23 is patentable thereover for at least this reason.

Dependent claims 24-27 depend from claim 23, and are allowable for at least the same reasons, as well as for patentable features recited therein.

Independent claims 30 and 32 recite, respectively, “recording the information about usage of the memory card in an area of memory of the memory card” and “an area of memory of the memory card for recording the information about usage of the memory card” in a similar fashion to 23, and are patentable for at least the reasons discussed above with respect to claim 23.

Moreover, claims 30 and 32 require that the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card. This feature is also not disclosed by Himoto. The Office Action on page 20 alleges that Figures 5A-5E, 6A-6C and col. 10, lines 64-67 of Himoto disclose this feature. Applicants respectfully disagree. Figures 5A-5E and 6A-6C merely illustrate the address region in which a program is stored. Himoto, however, does not disclose that a measurement of how full the memory is is recorded in a memory card. Appellants submit that a stored program is not a measurement of how full a memory card merely because that program is stored in a memory between certain addresses of the memory card.

Claims 31 and 33 depend from claims 30 and 32, respectively, and are patentable for at least the same reasons as well as for further patentable features recite therein.

Bueno was cited for allegedly disclosing counting the number of times a memory card is inserted into an electronic device, but fails to cure the deficiencies of Bruce, Shimizu and Himoto. No was cited for allegedly disclosing a memory card for use in a digital camera. No, however, also fails to disclose or suggest monitoring usage of the memory card, and storing the usage of the memory card on the memory card, and fails to cure the deficiencies of Bruce, Shimizu and Himoto.

Applicants believe that the present application is now in condition for allowance.  
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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